REMARKS

Rejection under 35 USC § 112

The Examiner has rejected Claims 1-8 under 35 USC § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant has amended Claim 1 to add a method step. Claims 2 and 3 have been canceled. Claims 4-8 depend on amended Claim 1. Reconsideration and withdrawal of the rejection to Claims 1 and 4-8, as amended, under 35 USC § 112 are therefore respectfully requested.

Rejection under 35 USC § 103(a)

It is basic patent law that the rejection of the present invention under 35 U.S.C. § 103 must comport with the classic standard set forth in *Graham v. John Deere Company* 383 US 1, 148 USPQ 459 (1966), codified in MPEP Section 706. The Supreme Court's guidance in that landmark case, requires that, to establish a *prima facie* case of obviousness, the USPTO must:

(1) Set forth the differences in the claims over the applied references;

(2) Set forth the proposed modification of the references which would be necessary to arrive at the claimed subject matter; and

(3) Explain why the proposed modification would be obvious.

To satisfy Step (3), the Patent Office must identify where the prior art provides a motivating suggestion to make the modification proposed in Step (2). See *In re Jones*, 958 F2d 347, 21 USPQ 2d 1941 (Fed. Cir. 1992). The mere fact that the prior art may be modified as suggested by the Patent Office does not make the modification obvious unless the prior art suggests the desirability of the modification. See *In re Fritch*, 972 F2d 1260, 23 USPQ 2d 1780 (Fed. Cir. 1992).

The Examiner has rejected Claims 1-8 under 35 USC § 103(a) as allegedly obvious over Kaiserman (hereinafter "Kaiserman") U.S. Patent No. 5,338,474 as applied to the present claims alone, in addition to or in combination with Ofosu-Asante et al. (hereinafter "Ofosu") WO Patent No. 98/03621. The Examiner admits that Kaiserman and Ofosu fail to teach a method of using a specific diacyl peroxide to provide stain removal and improved fabric color safety (see Office Action, paper 4, page 5, last paragraph). The Examiner asserts that it would have been obvious to formulate a bleaching composition containing a specific diacyl peroxide which provides stain removal and improved fabric color safety as recited by the instant claims, with a reasonable expectation of success because of the broad teachings of Kaiserman and Ofosu. The Examiner's rejection is again respectfully traversed.

In determining obviousness the court considers what the prior art collectively suggests to one of ordinary skill in the art. *Leinoff v. Louis Milona & Sons Inc., 726 F.2d 734, 739 (Fed. Cir. 1984).*

Teachings of the prior art, however, cannot be combined to declare an invention obvious absent some teaching, suggestion, or other incentive in the art to combine the teachings. *Carella, 804 F.2d at 140.* With regards to the cited references, there is no motivation to modify their disclosures in a way necessary to obtain Applicants' invention. First, there appears no specific teaching or suggestion in either Kaiserman or Ofosu of a method of using a specific diacyl peroxide, wherein R_1 is an aliphatic group having from 1 to 30 carbon atoms and is selected from either linear, branched, cyclic, saturated, unsaturated, substituted, unsubstituted or mixtures thereof and R_2 is an aromatic group selected from mono or polycyclic ring, homo or heteroatomic, substituted or unsubstituted or mixtures thereof, to provide stain removal and improved fabric color safety as recited by the instant claims. It is respectfully submitted that these selections and substitutions suggested by the Examiner constitute no more than a hindsight reconstruction of the present invention. Taken as a whole, the references constitute no more than a listing of the individual ingredients that can be used in Applicants' compositions once Applicants' invention has been arrived at. The Examiner's attention is directed to the fact that citing references that merely indicate that isolated elements and/or features cited in the claims exist is not sufficient basis for concluding that the combination of claimed elements would be obvious in the sense of 35 USC §103. *Ex parte Hiyamizu*, 10 USPQ 1393, 1394 (BPAI 1988).

Second, there is no suggestion that such compositions should be prepared with the expectation that they would be useful in stain removal and improved fabric color safety as recited by the instant claims. Thus, it is submitted that Claims 1 and 4-8, as amended, as well as, new Claims 9-11 are patentable over Kaiserman or Ofosu alone or in combination. It is important for the Examiner to note that both Kaiserman and Ofosu fail to disclose fabric color safety in their patents. Yet, somehow the Examiner asserts that there is a "reasonable expectation of success" and one of ordinary skill in the art would formulate a bleaching composition with "similar results". Where does the Examiner base this assertion? On inherency?

To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.' ... 'Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' "); *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f 1990) ("In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art.") (emphasis added).

As discussed hereinbefore, Kaiserman teach a wide variety of bleaching systems for releasing a peroxygen bleach source using esterase enzymes (see Kaiserman, col. 2, lines 1-18). Ofosu teach a

treating comprising a bleaching agent which may be diacyl peroxide (see Ofosu, page 4, lines 1-10). Yet, there is no technical reasoning provided by the cited prior art to reasonably expect a method of using a specific diacyl peroxide, wherein R_1 is an aliphatic group having from 1 to 30 carbon atoms and is selected from either linear, branched, cyclic, saturated, unsaturated, substituted, unsubstituted or mixtures thereof and R_2 is an aromatic group selected from mono or polycyclic ring, homo or heteroatomic, substituted or unsubstituted or mixtures thereof, to provide stain removal and improved fabric color safety in the manner recited by the Applicants.

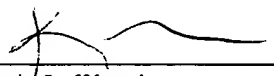
In short, it is submitted that the Examiner's conclusion that it would be obvious to expect success and similar results to formulate a bleaching composition containing a specific diacyl peroxide, wherein R_1 is an aliphatic group having from 1 to 30 carbon atoms and is selected from either linear, branched, cyclic, saturated, unsaturated, substituted, unsubstituted or mixtures thereof and R_2 is an aromatic group selected from mono or polycyclic ring, homo or heteroatomic, substituted or unsubstituted or mixtures thereof, which provides stain removal and improved fabric color safety with respect to other disclosed components in the broad disclosure of the referenced art to arrive at Applicant's invention herein flies in the face of the facts of record. In that regard, the Examiner's attention is directed to the recent case *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). In that case, the Federal Circuit, once again, cited numerous cases for the principle that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See, e.g., *C. R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998); *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 297, 227 USPQ 657, 667 (Fed. Cir. 1985) and *Graham*, 383 U.S. at 18, 148 USPQ at 467. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability -- the essence of hindsight. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985).

In summary, it is submitted that either Kaiserman or Ofosu, alone or in combination are inappropriate in the present circumstances in view of the case law cited hereinabove. In combining broad disclosures, the Examiner, in hindsight, is doing what none of those inventors had done. Accordingly, reconsideration and withdrawal of the rejection of Claims 1 and 4-8, as amended, are respectfully requested.

CONCLUSION

Applicant .has made an earnest effort to place the present claims in condition for allowance. WHEREFORE, entry of the amendments provided herewith, reconsideration of the claims as amended in light of the Remarks provided, withdrawal of the claims rejections, and allowance of Claims 1 and 4-8, as amended, and new Claims 9-11 are respectfully requested. In the event that issues remain prior to allowance of the noted claims, then the Examiner is invited to call Applicant's undersigned Attorney to discuss any remaining issues. He can be reached at the Procter & Gamble Company at (513) 627-7386.

Respectfully submitted,

By 

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K:/KLW/International Cases/CM1647/CM 1903 Amendment

VERSION WITH MARKED UP CHANGES

IN THE SPECIFICATION

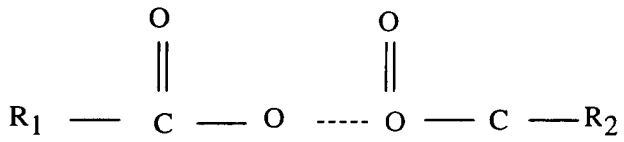
An Abstract has been provided.

--The present invention relates to a method of using an aliphatic-aromatic diacyl peroxide in a bleaching composition to provide improved stain removal performance and reduce color damage of colored fabrics.--

IN THE CLAIMS

Claims 1, 4 and 6 have been amended. Claims 9 and 10 have been added.

1. (Amended) A method for removing stains from fabrics and improving fabric color safety, said method comprising the step of contacting a soiled fabric with a bleaching composition comprising [The use of] a diacyl peroxide of general formula:



wherein R_1 is an aliphatic group having from 1 to 30 carbon atoms and is selected from either linear, branched, cyclic, saturated, unsaturated, substituted, unsubstituted or mixtures thereof and R_2 is an aromatic group [in a bleaching composition to provide stain removal and improved fabric colour safety] selected from mono or polycyclic ring, homo or heteroatomic, substituted or unsubstituted or mixtures thereof.

2. (Canceled)

3. (Canceled)

4. (Twice Amended) The [use] method according to Claim 1 wherein R_1 and R_2 are independently substituted with a halide, sulphur-containing functionality, nitrogen-containing functionality, an alkyl chain wherein the number of carbon atoms in the alkyl chain ranges from 1 to 20[, preferably from 4 to 12].

5. (Twice Amended) The [use] method according to Claim 1 wherein the diacyl peroxide is benzoyl alkanoyl peroxide wherein the alkanoyl group has from 8 to 18 carbon atoms.

6. (Twice Amended) The [use] method according to Claim 1 wherein the diacyl peroxide is selected from the group consisting of benzoyl lauroyl peroxide, benzoyl decanoyl peroxide, benzoyl cetoyl peroxide, para-alkyl benzoyl lauroyl peroxide, para-alkyl benzoyl decanoyl peroxide, para-alky benzoyl cetoyl peroxide [where the alkyl is preferably a pentyl and mixtures thereof.].

7. (Twice Amended) The [use] method according to Claim 1 wherein the bleaching composition is aqueous.

8. (Twice Amended) The [use] method according to Claim 1 wherein the bleaching composition comprises at least one surfactant.

9. (New) The method according to Claim 1 wherein said R_1 is an aliphatic group having from 4 to 20.

10. (New) The method according to Claim 4 wherein said number of carbon atoms in said alkyl chain ranges from 4 to 12.

11. (New) The method according to Claim 6 wherein said alkyl is a pentyl and mixtures thereof.

ABSTRACT

The present invention relates to a method for removing stains from fabrics and improving fabric color safety using an aliphatic-aromatic diacyl peroxide in a bleaching composition.